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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/729,341	10/16/1996	OPHIRA R. AHARONSON		3864

7590 07/28/2003

RINES AND RINES  
81 NORTH STATE STREET  
CONCORD, NH 03301

[REDACTED] EXAMINER

NGUYEN, CHANH DUY

ART UNIT	PAPER NUMBER
2675	4

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	08/729,341	AHARONSON ET AL.
	<b>Examiner</b> Chanh Nguyen	<b>Art Unit</b> 2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 May 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-11 and 20-42 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11 and 20-42 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Response to Amendment***

1. The amendment filed on May 6, 2003 has been entered and considered by examiner.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-11 and 20-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 32 copied from Cotte's reference (U.S. Patent No. 5,499,108) recite "wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". However, there is no description in the specification to support the feature of the placement alone is sufficient to initiate said drawing nor means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data. The closest disclosure in the specification is as follows:

(a) Figure 1 of the application shows a monitor (H2), but does not disclose the feature of "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

(b) On page 18, lines 14-18 of the specification discloses a master mode which the scanner automatically starts scanning, but does not discloses the limitations "means for displaying, in response to said replacement, a plurality of user-selectable options for processing said image data".

(c) On page 22, last line to page 23, line 2, discloses that "the user may choose to use a scanner for data input by picking operation from a menu or typing a specification", but does not disclose the feature "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". For example, the specification does not disclose a menu displayed on the screen. The menu mentioned in the specification may be placed on the keyboard before replacement. Even the menu of the specification is displayed on the monitor, but the specification does not disclose the limitation "means for displaying, in response replacement..."

No where in the specification discloses the limitation "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

Dependent claims 8-9 and 23-24 recite the limitations ""scanning means sends an interrupt to said computer in response to said replacement" and ""said image data periodically polls said input device". However, nowhere in the specification discloses

such limitation above. Page 18, lines 14-18 of the specification describes a master mode with the host receives the scanned data into "spool" directory where it is stored for application to retrieved it, but does not mention the limitations "interrupt" nor "periodically polls" as recited in the claims.

In dependent claims 20 and 26 recite the limitation "a plurality of user selectable options for processing said image data wherein said placement alone is sufficient to initiate display of said options". Again, nowhere in the specification discloses this limitation for the same reason as addressed in claim 1.

The remaining claims 2-11, 21-25, 27-31 and 33-42 are rejected to as being dependent upon a rejected base claims.

In view of lacking written description, no art rejection has been applied since the specification does not support the limitations recited in the claims 1-11 and 20-42.

***Response to Arguments***

4. Applicant's arguments filed May 6, 2003 have been fully considered but they are not persuasive.

On pages 8-9 of the Remarks, applicant argues that the suspension mailed on March 02, 1999 should not be made because the suspension should be made when the application is in condition for allowance. Examiner would like to present his point of view as following reasons: First of all, the claims of the application are copied from the reexam application number 90/004,486 as stated in the suspension letter. Secondly, if the applicant finds an error of the suspension, then a petition can be made by applicant

so that the suspension can be withdrawn because there is no record indicating that any claims are allowed.

On page 10, lines 3-15, applicant cites pages 13 and 14 of specification and argues that "there is no further action required on the slave output device of the data to be displayed", and "there is further action needed to be performed by the user on the slave printer itself. However, pages 23 and 24 (not pages 13 and 14 as applicant citation) of the specification simply describe how the keyboard-scanner device can function as different device (see page 24, lines 1-3). That is a regular keyboard mode and a keyboard master mode. The recitation "in this mode or operation, the master device is the keyboard-scanner of the invention, and the computer is used as a slave output device for display communication and printing" cited on page 23 does not disclose the limitation "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data" as recited in the claims because it simply describe the keyboard special functions keys automatically converting to "fax/copy" machine function (see page 24, last line through page 25, line 2).

On page 10, lines 16 through 29, applicant cites a paragraph from page 18 of the specification "Master mode- the scanner automatically starts scanning, initiated communication protocol with the host computer and the host receives the scanned data into a spool directory where it is stored for application to retrieve it", and argues that the use of the spool directory is further well-known in the art. However, the spool directory described by applicant does not display a plurality of user selectable option on the screen in response to the placement as required by claims. The spool directory is well-

known in the art, but it is not necessary to display the spool directory or menu on the screen

On page 11, first paragraph, applicant argues that selection of menu functions is (and was at the time of the filing of the application) an obvious and well-known and inherent operation for any application in the art. However, examiner would like to present his point of view as follows: First of all, the menu selection is not obvious or inherent for any application in the art because it requires larger memory to store the function of menu which some device may not have it. Secondly, examiner agrees with applicant that the menu selection is well-known in the art to display the display screen. However, if the specification of the invention does not disclose it, then the menu selection should not be claimed. For example, many other features in the art of computer such as flash memory, OLED display screen, CD, DVD are well-known, but does not obvious or inherent to equip the listed above to all the computer. Some does have CD, some does not. Some has flash memory, but others do not have it for different reasons.

On page 11, second paragraph, applicant presents similar argument as present in the menu selection (that is inherent and well-known in that art) that "it is well-known that this operation can only use one of two options-- polling or interrupted for master/slave operation... there are no other option but to poll or interrupt". Again, the specification does not even mention a word about "interrupt" nor "periodically polls". It is not inherent when the facts does not provide to the specification or the argument as applicant's presented.

As to independent claims 20 and 26, applicant argues that "applicant have fully disclosed that document placement alone is sufficient to start the scanning application in the master mode". However, the specification (page 18, lines 14-18) discloses a master mode which the scanner automatically starts scanning, but does not discloses the limitation "a placement alone is sufficient to initiate display of said options". Automatic scanning document in the scanner cannot be interpreted as "automatically starts displaying". Applicant further argues menu selection is well-known in MS-Window or MAC or X-Window. However, the argument is not persuasive because the invention does not disclose display the menu in response the placement nor even mention the use of MS-Window, MAC or X-Window on the display screen.

The last two paragraph of page 12, applicant argues that "applicant do not understand the criticism of the drawings offered by the new examiner since the drawings have long since been approved and printed in connection with parent application 472,573 , now US Patent 5,623,285". However, the drawing objection on form PTO-948 is not from examiner, it is from Draftsperson for reviewing the drawings (see the title of PTO-948 "Notice Of Draftsperson's Patent Drawing Review". The drawings in the application 472,573 have been approved, but it is not necessary that they have to be approved in this application because of the deficiencies listed on the form PTO-948.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanh Nguyen whose telephone number is (703) 308-6603.

If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Steven Saras can be reached at 305-9720.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Art Unit: 2675

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the Technology Center 2600 Customer Service Office  
whose telephone number is (703) 306-0377.

*CN*  
C. Nguyen  
July 17, 2003

*Chanh Nguyen*  
CHANH NGUYEN  
PRIMARY EXAMINER